## REMARKS

Claims 30-36 are pending in the present application. Claims 1-29 and 37-44 have been cancelled.

In the Office Action dated August 26, 2004, the Examiner provisionally rejected claim 30 under the judicially created doctrine of obviousness-type double patenting and being unpatentable over claims 11-29 and 37-44 of co-pending Application No. 09/943,894. Claim 30 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11, 23, 37, 41 and 44 of U.S. Patent No. 09/943,894.

Claim 33 was objected to because of a typographical error (which has been corrected in the present amendment).

The drawings were objected to for failing so show every feature of the invention specified in the claims, particularly with respect to the element "**if the Email communication is designated for the plurality of recipients,**" and for failing to show "deleting the stored Email communication notification by the Email communication program. The Examiner asserted that these elements must be shown or the features canceled from the claims.

Claim 30 was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement for reciting the phrase "if the Email communication notification distinct from the Email communication". Claim 32 was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement for reciting "after the indicating to the Email communication program to delete the Email communication, **deleting the stored Email communication notification by the Email communication program**, even if all recipients have not indicated to the Email communication program to delete the Email communication." (Examiner's emphasis ).

Claims 30, 34, and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (U.S. Patent No. 6,067,561) in view of Aronson et al. (U.S. Patent No. 6,654,787). Claim 31 was rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (U.S. Patent No. 6,067,561) in view of Aronson (U.S. Patent No. 6,654,787) in further view of Arnold (U.S. Patent No. 6,275,848). Claim 33 was rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (U.S. Patent No. 6,067,561) in view of Aronson (U.S. Patent No. 6,654,787) in further

view of Arnold (U.S. Patent No. 6,275,848) with what is well known in the art. Claim 32 was rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6,067,561) in view of Aronson (U.S. Patent No. 6,654,787) in further view of Arnold (U.S. Patent No. 6,275,848) in further view of Devine et al. (U.S. Patent No. 6,385,644). Claim 36 was rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (U.S. Patent No. 6,067,561) in view of Aronson (U.S. Patent No. 6,654,787) in further view of Homan et al. (U.S. Patent No. 6,317,485).

Applicant disagrees with the Examiner's rejections and objections, and requests reconsideration of in view of the following remarks.

**Obviousness type double Patenting.**

With respect to the obviousness type double patenting rejection over claims 11-29 and 37-44 over copending sibling application No. 09/943,894, the terminal disclaimer submitted herewith obviates this ground of rejection.

**Rejections under § 112, first paragraph, and Objections to the Drawings.**

Applicant disagrees with the Examiner's rejections and objections to the drawings, and requests reconsideration of in view of the following remarks.

As an initial matter with respect to the rejections under § 112, first paragraph, Applicant respectfully submits that the Examiner seems to have convoluted the distinction between the § 112, first paragraph, "written description" requirement and the "enablement requirement." The MPEP § 2163 (I) states that the "The first paragraph of 35 U.S.C., 112 requires that the 'specification shall contain a written description of the invention.' This requirement is separate and distinct from the enablement requirement." "To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." MPEP 2163, citing *Vas-Cath Inc., v Mahurkar, 935 F.2d at 1563* (Fed. Cir. 1991). In contrast, "The test for enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." MPEP 2164.01, citing *United States v. Telectronics, Inc* 857 F.2d 778 (Fed. Cir. 1988).

Each of the Examiner's rejections under section 112, first paragraph, for alleged lack of enablement (and the objections to the drawings) appears to be based on a requirement that the specification or drawings describe the invention in the claims verbatim. There is no assertion by the Examiner that one of ordinary skill in the art is not able to make and use the claimed invention without undue experimentation based on the specification.

Moreover, with respect to the objections to the drawings, the field of the present invention is software. The Federal Circuit has held that "[a]s a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed. Thus, flow charts or source code listing are not a requirement for adequately disclosing the function of software." (emphasis added) MPEP, 2164 (I)(A) citing *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543 (Fed. Cir. 1997). Accordingly, the Examiner's objections to the drawings should be withdrawn.

Also, the rejections for lack of enablement should be withdrawn because whether the present claims can be implemented without undue experimentation has not been questioned in the present case. Applicant will accordingly address the rejections under section 112, presuming that the Examiner intended to draw the rejections under the written description requirement rather than the enablement requirement of § 112, first paragraph.

The Examiner's rejections under 112, first paragraph, each appear to be improperly based on a requirement that the written description (or the drawings) describe verbatim what is recited in the claims. "While there is no *in haec verba* requirement, newly added limitations must be supported in the specification through express, implicit or inherent disclosure." (MPEP, 2163(I)(B) Moreover, the Examiner has overlooked that the present claims use the same language as the original claims, or merely rephrase the language to clarify the invention. "It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification." MPEP 2163.(I).

With respect to the rejection of claim 30 under section 112, first paragraph, for reciting "**if** the Email communication notification distinct from the Email communication," Applicant notes that this appears to be a typographical error. The pertinent part of Claim 30

recites, "if the Email communication is designated for the plurality of recipients..." Applicant believes this recited element was the intent of the Examiner's rejections because it is consistent with the Examiner's objection to the drawings. As such, Applicant respectfully submits that there is implicit and explicit support for this limitation in specification as a whole and in the original filed claims.

First, the entire specification, including the Background section makes it clear that the context of the invention is for when multiple recipients are designated. For example to contrast with the problems of the prior art, at page 1, line 16 it is stated "For example, when an electronic message is to be sent to multiple recipients, current messaging systems deliver a separate copy of the message from the sender's system to each of the recipients' system...Each recipients' system that receive the message is then responsible for storing and managing the message." By implication, the claimed method, which solves the problem by storing a single copy of the message, is used in cases when multiple recipients are designated.

Second, originally submitted claim 11 explicitly recited in pertinent form "when it is determined that multiple recipients have been indicated...." and/or "....for determining whether multiple recipients of the electronic communication have been indicated." Applicant submits that the terms "when" and "determining whether" as submitted with the original claim 11 are ordinarily understood to have the same conditional meaning as "If" as presently incorporated from claim 11 into claim 30. This element was added to claim 30 in the response mailed June 3, 2004, to help distinguish over the art of record in a manner corresponding to the amendment made to the copending divisional application No. 09/943,894.

The amendment was made to clarify the original meaning of the conditional terms "when" or "determining whether" that were originally in claim 11 and are now incorporated into claim 30. The equivalence of the conditional term "if" with the conditional terms "when" or "determining whether" is commonly understood in ordinary parlance. For example, the patent Examiner might state that "the claims will be allowed when they are distinguishable over the art" or might state "my job is determining whether claims are distinguishable over the art before issuing a notice of allowance." In each case, the intent of "when" or "determining whether" has the same conditional meaning as "If". Thus the term "If" does not add new matter because the original claims form part of the original specification. Because the term "If" is supported by the

meaning of the original conditional terms "when" or 'determining whether" in claim 11 as originally filed, there is support in the specification for this limitation being added to claim 30 so the rejection on this ground should be withdrawn.

With respect to the Examiner's rejection of claim 32 for reciting, in the Examiner's emphasized part, "...**deleting** the stored Email communication **notification by the Email communication program...**," Applicant respectfully traverses this ground of rejection. The specification at page 6, lines 20-25 states:

> The recipient can also provide various instructions about actions to be taken with a message corresponding to an indicator, such as to save or delete the message or to forward the message to another reipient. An instruction to delete the message has an immediate effect on the indicator stored locally on the recipient system (i.e., the indicator is deleted or no longer displayed to the user).

(Emphasis added). It is clear from the specification that the "indicator" is sent in the notification. For example, page 5, line 15 states in pertinent part "...and sends to each recipient a short indicator message to notify the recipient that the electronic message is available." (Emphasis added). Thus, to delete the notification as recited in claim 32 is the same as to delete the indicator stored locally on the recipient's system as expressly taught in the specification. Moreover, originally submitted claim 32 recites the exact same language. As mentioned before, the original claims form part of the original specification. Moreover, "There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed." MPEP 2163.01(I)(A). No further description is required because the claims are part of the original description, and the subject matter is a function performed by software. Hence, the claims filed in the original specification provide the needed written support for the claim limitations therefore, the rejection of claim 32 on this ground should be withdrawn.

**Applicant's Teaching in Comparison to the Cited Art**

Applicant disagrees with the Examiner's rejections of the claims as obvious over Dillon in view of any combination with Aronson, Arnold, Devine, Homan or the official notice taken by the Examiner. Applicant has previously discussed the deficiencies of these references in the response filed June 3, 2004. The Examiner considered the previously filed response to be moot in view of the present grounds of rejection and did not address those arguments. These

arguments are repeated and/or modified herein because the exact same references are being used for the similar grounds of rejection.

The disclosed embodiments of the invention will now be discussed in comparison to the prior art. Of course, the discussion of the disclosed embodiments, and the discussion of the differences between the disclosed embodiments and the prior art subject matter do not define the scope or interpretation of any of the claims. Instead, such discussed differences merely help the Examiner appreciate important claim distinctions discussed thereafter.

Applicant discloses a method and system for an Email communication program that securely distributes an electronic message (*i.e.*, electronic communication) that is designated for a plurality of different recipients in an efficient manner using centralized storage and management. In particular, the method implemented by the Email communication program involves storing a single copy of the message on a server, *specifically conditioned whether the message is designated for a plurality of recipients*. Unlike conventional methods, the present method *makes a decision whether the Email is designated for a plurality of recipients*, to determine whether to *store a single copy of the message on the server*. The system does not send the message to any recipient until it receives a response from at least one of the recipients that contains a request for the message. If the indication is not for multiple recipients the message is sent to the recipient without being stored.

In various embodiments, the Email communication program tracks, tests and routes requests from the recipients to access the message when appropriate and deletes the stored message when all recipients have responded and therefore all have received the message, unless at least one recipient requests that message be saved. The Email communication program also permits the user to perform certain local actions without perturbing the basic functionality of the system. For example, one recipient may send an instruction to the Email communication program to delete the Email communication. However, only one copy of the Email communication has been stored by the program, and under certain conditions, all recipients may not have seen the message. Rather than delete the stored copy of the Email communication, the system deletes the local notification of the Email communication that was sent to that particular user and stored locally on the recipient's system, leaving the single copy of the communication stored on the server unperturbed. In other examples, the recipient user may individually store a

copy of the Email communication locally on the recipient's system, regardless of the actions taken by the Email communication program with respect to deleting or storing the single copy of the Email communication.

Thus, a single copy of the message is on a server computer for delivery on an individual basis to multiple recipients when requested. In various embodiments, the Email communication program also receives instructions related to a particular recipient regarding the type of notification to be performed for that particular recipient, and sends the notification according to those instructions of that particular recipient In certain embodiments, the notification instructions are tailored by a particular recipient and in others, the notification instructions are automatically assigned for a particular recipient. In some cases the notification instructions indicate the message is to be encrypted, and the system performs the encryption accordingly. In certain embodiments, after all recipients have reviewed the message and no recipient has indicated a choice to save the message (or all have indicated a choice to delete the message) the system automatically deletes the single copy of the message. The instructions may include actions to be taken with respect to the message, such as to save or delete the message or to forward the message to another recipient.

The centralized storage and management of electronic messages to be distributed to a large number of recipients provides a variety of benefits. Because only a short indicator is sent to each recipient, the recipients' systems require only a small amount of storage space. In addition, each recipient system does not need the necessary software to save and manage the electronic messages. Instead, the recipient system need only be able to display a message and to send requests and other message action instructions to the server. In addition, central storage of the message provides easy access and control of the original message by an appropriate authorized user who may need access to the centrally-stored message for any number of reasons (*e.g.*, for backup, for authentication, or for modification). Removal or modification of the message to be distributed to a large number of users is therefore easily accomplished.

The cited prior art references, alone or in combination, fail to teach the combination of features of Applicant's embodiments in any manner that would fairly suggest or motivate one of ordinary skill in the art to create a message management system like Applicant's.

**Dillon**. Dillon is directed to sending notifications (alerts) of Email messages to recipients using a hybrid network that transmits notifications via a continuous high speed channel. Other than these features and in particular, the features regarding how the alerts are sent, the handling of messages as taught by Dillon is conventional in the art.

Applicant respectfully submits that the Examiner has mischaracterized the teaching of Dillon by reading more into that reference than is actually taught therein. In particular, the Examiner stated that "Dillon teaches a computer-implemented method for *one of a plurality of designated recipients* of an Email communication to receive the Email communication from *a server that stores a single copy of the Email communication*." In fact, Dillon is totally silent about whether *a single copy* of the email communication is stored when there are multiple recipients designated.

The cited text at col. 1, line 25, to col. 2, line 38, and col. 3, lines 12-65, teaches nothing about how to treat the Email communication that depends on whether a plurality of recipients is designated. The Examiner recognizes that Dillon does not specifically teach providing an Email communication program on a server that is configured with instructions to store a single copy of the Email communication on the server if the email communication is designated for the plurality of recipients. Applicant agrees, the cited text at most may be inferred to mean storing <u>copies</u> of the Email communication on a server for each recipient, and sending a notification of the Email communication to each subscriber. When taken for what it teaches as a whole, based on what one of ordinary skill in the art knows regarding how Email services conventionally operate, one would at most infer from Dillon that, if a plurality of recipients were designated, the Email communication would be stored in each of the subscriber's directories on the recipient's server, *i.e.,* multiple copies of the Email communication would be stored, one for each of the designated plurality of recipients.

In addition, the cited text at col. 1, lines 25 to col. 2, line 38, and col. 3, lines 12-68 does not teach that "the acts of receiving the notification, requesting the Email communication and receiving the Email communication are performed by a receiving computer lacking sufficient permanent storage to store the email communication" as stated by the Examiner at paragraph 25 of the Office Action. The cited text refers generally to local area networks, the Internet, and paging notification systems and makes no reference to implementing

the method particularly for receiving computers lacking sufficient memory for permanent storage.

Accordingly, Dillon fails to teach important elements taught by Applicant.

**Aronson**. Applicant also respectfully submits that the Examiner has mischaracterized the teaching of Aronson. The Examiner stated that "Aronson teaches providing and Email communication program on a server that is configured with instructions to store a single copy of the Email communication on the server if the Email communication is designated for the plurality of recipients." (*e.g.*, col. 8, line 30- col 9, line 10) In fact, the cited text teaches nothing whether or not a plurality of users have been indicated, let alone whether a single copy of the email communication is stored based on that criteria. Aronson as a whole is directed to filtering Email based on content, not based on designated recipients. The cited text specifically teaches storing a copy of the Email conditionally based on whether the content of the Email is designated as Spam, not whether a plurality of users are designated. It is unclear from the text whether a single copy of the email message is stored or not. Based on the preceding text at column 8, line 16-29, it is entirely possible that multiple copies of the email message are stored for each of the multiple users on the "network address of proxy server mail.proxy.com." In fact, the undersigned has done a text search of Aronson and cannot find the word "multiple" or "plurality" or "several" anywhere therein in any context related to the number of designated recipients of an email. Applicant respectfully submits that the Examiner is reading more into Aronson than is actually disclosed therein.

In any case, unlike Applicant's system, in the system described by Aronson, if the Email is Spam sent to one user, the system of Aronson would store a copy of the Email on the server anyway, because it is Spam. Conversely, also unlike Applicant's system, if the Email is authentic and sent to a plurality of users, the system of Aronson would still send the Email to each of the designated users and not store a single copy on the server, because storage of a copy on the server rather than the recipients "in box" in Aronson is conditionally based on the character of the Email (whether it is Spam), not the number of recipients that are designated.

Accordingly, Aronson alone or in combination with Dillon also fails to teach storage of a single copy of the email communication on the server based on whether a plurality of recipients are indicated.

Moreover, the motivation provided by the Examiner to combine Dillon and Aronson is "because it would be more efficient to conserve space with having one central location, having users reference the single copy of the email then having multiple copies of an email taking up substantial space." This is certainly one of the advantages of Applicant's embodiments, however, it is equally certain that neither Dillon nor Aronson teach the desirability of having such a method that provides such an advantage nor teaches a system to accomplish the same. The Examiner has not shown, and Applicant cannot find, where Dillon or Aronson would motivate one of ordinary skill in the art to provide such a method or system to store email messages in a single location conditionally based on whether a plurality of recipients were designated.

Even if the cited art taught what the Examiner said it taught (which it does not), it would still be impermissible hindsight for the Examiner to take the advantages expressly taught by Applicant's disclosure to retrospectively read the prior art to supply the motivation to combine the elements taught therein. It is well established, that the prior art references must be read without the benefit of hindsight based on what Applicant teaches, and it must be shown that one of ordinary skill in the art would be motivated by what is in the prior art to do what Applicant has done. Nothing in the prior art cited teaches anything about saving storage space when multiple recipients of the Email have been designated. Applicant respectfully submits that in the present case, the Examiner has used precisely what Applicant teaches is an advantage of the invention to provide a motivation (saving storage space when multiple recipients are designated), has read more into the prior art that is taught therein, and ultimately states that one would be motivated by the reason that Applicant teaches, to extract information from the prior art to do what Applicants have done. This is classic impermissible hindsight.

**Arnold**. Applicant further submits that the Examiner has not properly characterized Arnold, which was said to teach "when access to the Email communication is no longer desired by the recipient, indicating to the server to delete the Email communication, so that the server deletes the single stored copy of the Email communication after receiving indications from all recipients to delete the Email communication (*e.g.*, col. 4, line 25-col. 5, line 25)." What Arnold teaches at the cited passages and elsewhere, is detaching attachments from Email messages based on size (or type criteria), storing the attachment on the Internet, sending

all the designated recipients the Email message devoid of the attachment, but with an embedded URL link, and allowing the recipients access to the stored attachment through the link embedded in the Email message. The cited text does not refer to deleting the email message *per se*, but rather to deleting the attachment that has been detached from the original Email message. Arnold thus has three components, the first (original) Email, a detached attachment from the Email separately stored, and a second Email that includes an address of the stored attachment. The deletion referred to in the cited text is with respect to the stored attachment, not the original Email.

Accordingly Arnold alone or in combination with Dillon and Aronson still fails to teach elements of Applicant's embodiments.

**Official Notice**. Applicant admits that it is well known in the art to locally store an Email communication. What was not known in the art, however, was to provide an Email communication that performs the other functions of Applicant's system as described above. Applicant's system thus allows the recipient to still use the conventional local storage functionality, while at the same time, not perturbing the other aspects of the system, such as conditional storage of a single copy of the Email based on whether a plurality of recipients have been indicated, or, only deleting the local notification to the recipient, not the single stored Email communication itself, upon receipt of instructions to delete from less than all of the recipients.

**Devine**. Applicant would accept that the Inbox functionality described by Devine at col. 12, lines 40-55, may be construed as a repository for locally storing Emails. However, the Examiner has also cited this same text as teaching "deleting the stored Email communication notification even if all recipients have not indicated to delete Email communication." Applicant disagrees with this characterization, because the Email communication of importance in Applicant's invention is the single copy of the Email communication stored on the server, which is stored as a single copy because a plurality of recipients have been indicated. Devine does not teach such a single copy storage of the Email communication. Accordingly, Devine fails to cure the deficiency of the primary references in this regard.

**Homan**. Applicant accepts that Homan teaches a preference system for determining how a subscriber will be notified of an Email communication. However, Homan also fails to cure the deficiency of the primary references with regard to conditional storage of

the Email communication as a single copy on a server based on whether a plurality of recipients have been indicated.

**The Claims and Rejections**

Turning now to the claims and the rejections thereof, amended base claim 30 recites in pertinent part...providing an Email communication program on a server that is configured with instructions to store a single copy of the Email communication on the server if the Email communication is designated for the plurality of recipients... Applicant has explained herein that the term "if" is used as a substitute for the originally submitted claim terms "when" or "determining whether" to grasp the intended meaning. There is written support in the specification as whole for this meaning. Therefore the rejections under § 112, first paragraph, and the objections to the drawings should be withdrawn.

As discussed above, the determination of whether or not to store a single copy of the Email message based on whether or not it is designated for a plurality of recipients, as emphasized in the above, is not taught or suggested by any of the prior art. Moreover, the combination of references fails to provide any motivation for using such a method for handling Email communications. Therefore, Applicant requests withdrawal of the rejection of the base claim 30 on grounds of obviousness.

Each of the remaining claims 31-36 depend from an allowable base claim and are patentable at least for that reason. Applicant therefore also requests withdrawal of the rejection of these claims on grounds of obviousness. This is not an admission that patentability of any of these dependent claims rises and falls with the independent claims. For example, as mentioned above, Arnold fails to teach the elements of some of the dependent claims as asserted by the Examiner. However, this expedient is used herein in the interest of brevity. Applicant reserves the right to further distinguish the dependent claims over the cited art at a later time if necessary.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a timely Notice of Allowance are earnestly solicited.

Respectfully submitted,

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